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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/994,979	11/26/2001	Modasser El-Shoubary	13167	2943

7590 07/22/2003

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EXAMINER	
YOON, TAE H	

ART UNIT	PAPER NUMBER
1714	

DATE MAILED: 07/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
09/994,979	El-Shoubary et al
Examiner	**Group Art Unit**
T. Yoon	1714

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 1-48 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-48 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☐ All ☐ Some* ☐ None of the:

☐ Certified copies of the priority documents have been received.

☐ Certified copies of the priority documents have been received in Application No. _____.

☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____.

Attachment(s)

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☒ Notice of Reference(s) Cited, PTO-892

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Interview Summary, PTO-413

☐ Notice of Informal Patent Application, PTO-152

☐ Other _____

Office Action Summary

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-22 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 68-95 of copending Application No. 09/723,098. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instantly recited "[a] pigment comprising ---" permits the presence of polyethylene as evidenced by the instant claim 19 for example..

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-7, 12-16 and 24-26 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over DE 1234234.

DE teaches the instant pigments treated with an organic-acid phosphate compound in examples 3 and 4. Dried pigments and various acids are taught at page 1, lines 4 and 23-26 of the translated paper. Thus, the instant invention lacks novelty.

Claims 1, 2, 4, 6, 8, 10, 12 and 17-23 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Stramel (US 5,397,391).

Stramel teaches the instant pigments treated with an organic-acid phosphate compound at col. 4, lines 16-40 and in examples which inherently meet the instant reaction products. Pre-

treated pigments are taught at col. 3, lines 41-53 and methods of making phosphate esters treated pigments are taught at col. 3, lines 33-40 (spray drying), 54 to col. 4, lines 15. Also, the matrix resins such as polyethylene (col. 4,line 62) and an amount of pigments therein (col. 5, lines 29-33) are taught.

Thus, the instant invention lacks novelty.

Claims 1-9, 12-18, 21-27, 29, 31, 33, 35, 37, 39, 45 and 46 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Menovcik et al (US 5,876,493).

Menovcik et al teach the instant pigments treated with a phosphate and pyrophosphate compounds at col. 2, line 64 to col. 3, line 22. The method of treatement and pre-treated pigments are taught at col. 1, lines 52-57 and col. 3, lines 62-63.

Thus, the instant invention lacks novelty.

Claims 1-18, 21-27, 29, 31, 33, 35, 37, 39, 45 and 46 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Menovcik et al (US 5,876,493).

The use of triethanolamines would be a *prima facie* obviousness since Menovcik et al teach dimethylethanol amine and a homologue thereof would be expected act in a similar or same manner.

Claims 28, 30, 32, 38, 40, 47 and 48 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Dupuis et al (US 5,53,630), Losoi (US 5,165,995) or Sole et al (US 4,500,361).

Dupuis et al teach the instant metaphosphate treated titanium dioxides at col. 2, lines 19-23. Losoi (example 1) and Sole et al (examples 2 and 6) teach the same.

Thus, the instant invention lacks novelty.

Claims 28, 30, 32, 34, 36, 38, 40, 47 and 48 are rejected under 35 U.S.C. 103(a) as obvious over Dupuis et al (US 5,53,630), Losoi (US 5,165,995) or Sole et al (US 4,500,361) in view of Menovcik et al (US 5,876,493).

The instant invention further recites akanolamine over Dupuis et al, Losoi and Sole et al who teach neutralization.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to utilize dimethylethanol amine taught by Menovcik et al and a homologue thereof in Dupuis et al, Losoi or Sole et al since Dupuis et al, Losoi and Sole et al teach neutralization.

Claims 1, 2, 17, 21, 23, 27, 28, 37-40 and 45-48 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Abeck et al (US 3,652,334).

Abeck et al teach the instan tpigment treated with a phosphate, metaphosphate and pyrophosphate compounds at col. 2, lines 18-33. The use of said pigment in various polymers is taught at col. 3, lines 51-59. Thus, the instant invention lacks novelty.

Claims 1, 2, 17, 19, 21, 23, 27, 28 and 37-48 are rejected under 35 U.S.C. 103(a) as obvious over Abeck et al (US 3,652,334) without or with Stramel (US 5,397,391).

The instant invention further recites polyethylene. However, Abeck et al teach the use of said pigment in various polymers is taught at col. 3, lines 51-59.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to utilize polyethylene in Abeck et al without or with teaching of Stramel since Abeck et al teach the use of said pigment in various polymers and since the use of a phosphate treated pigment in polyethylene is well known as taught by Stramel.

Claims 1-7, 12-20 and 23-26 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Johnson et al (US 5,466,482).

Johnson et al teach the instant pigments treated with an organic-acid phosphate compound in abstract and at col. 1, lines 34-63. Hydrogen as M and C_6 alkyl (hexyl) as R, for example mmet the instant formula. Various methods (col. 4, lines 26-52), TiO_2 (col. 4, lines 63-64) and polyolefins (col. 5, lines 14-15) are taught also.

Thus, the instant invention lacks novelty.

Claims 1-7 and 12-26 are rejected under 35 U.S.C. 103(a) as obvious over Johnson et al (US 5,466,482).

The instant invention further recites an amount of pigments in a polymer matrix.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to utilize the claimed amount of pigments in a polymer matrix of Johnson et al since the use of a higher amount of pigments in order to obtain a masterbatch is a routine practice in the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H. Yoon whose telephone number is (703) 308-2389. The examiner can normally be reached on Monday to Thursday from 8:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

THY/July 21, 2003

TAE H. YOON
PRIMARY EXAMINER